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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/129,238      08/05/98      SARDOY      V      4101-0206-55

022850      IM62/0606  
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EXAMINER

YEE, D

ART UNIT

PAPER NUMBER

1742

DATE MAILED:

06/06/00

**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner of Patents and Trademarks**

# Office Action Summary

Application No.

09/109,238

Applicant(s)

Sardoy et al.

Examiner

Lee

Group Art Unit

1742

—The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address—

## Period for Response

A SHORTENED STATUTORY PERIOD FOR RESPONSE IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a response be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for response specified above is less than thirty (30) days, a response within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for response is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to respond within the set or extended period for response will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

## Status

- ☐ Responsive to communication(s) filed on \_\_\_\_\_.
- ☐ This action is **FINAL**.
- ☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

## Disposition of Claims

- ☒ Claim(s) 8 to 20 is/are pending in the application.
- ☐ Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- ☒ Claim(s) 8 to 20 is/are rejected.
- ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- ☐ Claim(s) \_\_\_\_\_ are subject to restriction or election requirement.

## Application Papers

- ☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- ☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.
- ☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119 (a)-(d)

- ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
  - ☐ All ☐ Some\* ☐ None of the CERTIFIED copies of the priority documents have been received.
  - ☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_.
  - ☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_

## Attachment(s)

- ☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). \_\_\_\_\_
- ☐ Interview Summary, PTO-413
- ☐ Notice of References Cited, PTO-892
- ☐ Notice of Informal Patent Application, PTO-152
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Other \_\_\_\_\_

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***Claim Rejections - 35 USC § 103***

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 8 to 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over European patent 556834.

EP'834 discloses analogous ultra-low carbon steel sheet alloys which are processed in substantially the same manner as claimed by applicant except fails to recite the specific thickness of the hot rolled sheet and the percent reductions during hot and cold working. It is the examiner's position that these limitations would be a matter of routine optimization well within the skill of the artisan and productive of no new and unexpected results since criticality has not been demonstrated (e.g. by comparative test data).

***Response to Arguments***

3. Applicant's arguments filed March 30, 2000 have been fully considered but they are not persuasive. It was argued that EP'834 does not render obvious the claims, and that Examples 4 and 5 of the reference are the closest to the presently claimed steel but the reference fails to describe a combination of steel and processing steps as presently claimed. For example, the

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combination of the claimed composition of steel and the process step comprising coiling at the recited temperature is not rendered obvious by EP'384, which only describes a broad range of coiling temperature and generally uses steel having higher carbon, nitrogen and phosphorus contents, as well as additional boron.

It is the examiner's position that specific examples 4 and 5 in Table 2 of EP'834 meet the claimed composition except contains 0.006%N which is slightly higher than applicant's claimed N range of less than 0.006%. Since applicant has not demonstrated criticality (e.g by comparative test data, then it would seem that a composition with 0.006%N vs a composition with slightly less than 0.006%N would depict a mere difference in the proportion of element without any attendant unexpected results which would not patentably distinguish claim over prior art.

Even though examples 4 and 5 coil at 520C which is slightly lower than applicant's claimed coiling temperature of 530 to 570C, such would not be a patentable difference. Note that EP'834 broadly teaches a coiling temperature of 400 to 600C, and hence it would be a matter of routine optimization for one skilled in the art to used higher coiling temperatures depending on the desired properties. Moreover applicant's coiling temperature range of 530 to 570C fails to define patentable novelty over the reference whose coiling temperature range 400 to 600C, since there is nothing to show that it is critical or that it involves anything more than judicious selection; note that while applicant's specification indicates that 530 to 570C is preferred, a broad coiling temperature of below 620C is permissible , see last paragraph of page 4.

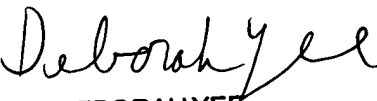
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***Conclusion***

4. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Deborah Yee whose telephone number is (703) 308-1102.

  
DEBORAH YEE  
PRIMARY EXAMINER

dy

June 5, 2000